

**Response under 37 C.F.R. 1.116**

Applicant: Eric L. Andersen et al.

Serial No.: 10/623,746

Filed: July 21, 2003

Docket No.: 100202636-1

Title: METHOD AND APPARATUS FOR IMAGING TRANSPARENCY SHEET MEDIA

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**REMARKS**

The following Remarks are made in response to the Final Office Action mailed December 24, 2008, in which claims 1-3, 9, 10, 13-16, 19, 20, and 27-37 were rejected.

Claims 1-3, 9, 10, 13-16, 19, 20, and 27-37 remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 102**

Claims 1, 2, 9, 10, 14, 15, 19, 27, 28, 30, 31, 33, 34, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,149,979 by Beaven et al.

Applicant respectfully traverses this rejection.

Independent claim 1 includes, amongst other things, **"forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image."**

Independent claim 9 includes, amongst other things, **"transmit the electronic mirror image to an imaging apparatus and form a mirror image on a sheet of transparency sheet media with the imaging apparatus in accordance with the electronic mirror image."**

Independent claim 14 includes, amongst other things, **"control the imaging engine to form a mirror image on a transparency sheet media in accordance with the electronic mirror image."**

Independent claim 27 includes, amongst other things, **"determining a mirror imaging selection for the electronic document file in response to detecting the transparency media designation, including detecting an automatic mirror imaging designation for the electronic document file as the mirror imaging selection" and "forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image."**

Independent claim 30 includes, amongst other things, **"detect an automatic mirror imaging designation of the electronic document file as a mirror imaging selection for the electronic document file in response to detecting the transparency media designation" and "transmit the electronic mirror image to an imaging apparatus and form a mirror image on a sheet of transparency sheet media with the imaging apparatus in accordance with the electronic mirror image."**

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Independent claim 33 includes, amongst other things, **"detect an automatic mirror imaging designation of the electronic document file as a mirror imaging selection for the electronic document file in response to detecting the transparency media designation"** and **"control the imaging engine to form a mirror image on a transparency sheet media in accordance with the electronic mirror image."**

Independent claims 1, 9, 14, 27, 30, and 33, therefore, each include forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image. In addition, independent claims 27, 30, and 33 each further include detecting an automatic mirror imaging designation for the electronic document file as the mirror imaging selection.

The Beaven reference discloses an operating system for managing data in a computer including a printer properties dialog module, a printer data module and a conflict dialog module, wherein the conflict dialog module is coupled to the printer data module and contains a list of conflicts whereby each conflict corresponds to a printer condition and a printer action (see Abstract). More specifically, the Beaven reference discloses that:

*A conflict arises when a user of the printer 10 chooses a condition from the printer setting and causes the printer driver to perform a predetermined action, the intended action and the selected condition may not be compatible to each other and produce an outcome that is not desired by the user (emphasis added) (col. 4, lines 45-49).*

Continuing, as an example of such a "conflict," the Beaven reference discloses that:

*...if a user [1] chooses from the printer setting of the printer 10 a condition "transparency" as paper type and [2] causes the printer driver to perform a "mirror" function, the intended "mirror" function or action and the selected condition "transparency" would produce an outcome of having a mirror image on a transparency, which may not be a desired outcome by the user. The printer data module 210 thus causes the conflict dialog module 230 to generate a conflict 232 from the list of conflicts corresponding to the condition "transparency" and the selected "mirror" function to be performed by the printer 10 to warn the user (emphasis added) (col. 4, lines 55-65).*

In response to the conflict of a mirror image on a transparency, the Beaven reference discloses that:

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*The user has the option to correct the conflict either by [1] selecting a new condition from the printer setting of the printer 10, [2] causing the printer driver to perform a new function, or [3] both [selecting a new condition and causing the printer driver to perform a new function]. Thus, catching a conflict and giving a user ability to correct or modify it according to the present invention enhances usability of the system (emphasis added) (col. 4, line 65 - col. 5, line 5).*

The system of the Beaven reference, therefore, identifies a mirror image on a transparency as a conflict. As such, the system of the Beaven reference presents the user with the option of correcting the conflict by selecting a new condition from the printer setting and/or causing the printer driver to perform a new function. The system of the Beaven reference, however, does not present the user with the option to "keep" the conflict, as asserted by the Examiner, and does not disclose the mirror image as being "printed" on the transparency, also as asserted by the Examiner. Accordingly, the Beaven reference does not disclose forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image, as recited in independent claims 1, 9, 14, 27, 30, and 33.

In addition, the system of the Beaven reference does not disclose automatic designation of the mirror function. Rather, and contrary to the assertion of the Examiner that the mirror image function is set "automatically" in response to the transparency selection, with the system of the Beaven reference, the user causes the printer driver to perform a "mirror" function. Accordingly, the Beaven reference does not disclose detecting an automatic mirror imaging designation for the electronic document file as the mirror imaging selection, as recited in independent claims 1, 9, 14, 27, 30, and 33.

In view of the above, Applicant submits that independent claims 1, 9, 14, 27, 30, and 33, and the dependent claims depending therefrom, are each patentably distinct from the Beaven reference and, therefore, are each in a condition for allowance. Applicant, therefore, respectfully requests that the rejection under 35 U.S.C. 102(e) be reconsidered and withdrawn, and that claims 1, 2, 9, 10, 14, 15, 19, 27, 28, 30, 31, 33, 34, and 36 be allowed.

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**Claim Rejections under 35 U.S.C. § 103**

Claims 3, 16, 20, 29, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,149,979 by Beaven et al., and further in view of U.S. Patent No. 4,891,517 by Ushiro et al.

Claims 13 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,149,979 by Beaven et al., and further in view of U.S. Patent No. 7,315,389 by Kuwata et al.

Applicant respectfully traverses these rejections.

Claim 3 depends from independent claim 1, claim 13 depends from independent claim 9, claims 16 and 20 depend from independent claim 14, claim 29 depends from independent claim 27, claim 32 depends from independent claim 30, and claims 35 and 37 depend from independent claim 33, and, as such, each include all of the limitations of the respective independent claims. As outlined above, Applicant submits that the Beaven reference does not disclose forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image, as claimed in independent claims 1, 9, 14, 27, 30, and 33, and does not disclose detecting an automatic mirror imaging designation for the electronic document file as the mirror imaging selection, as claimed in independent claims 27, 30, and 33.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As the Beaven reference does not disclose all the claim limitations of independent claims 1, 9, 14, 27, 30, and 33, Applicant submits that the Examiner has not established a *prima facie* case of obviousness of dependent claims 3, 13, 16, 20, 29, 32, 35, and 37. Applicant, therefore, respectfully requests that the rejections of claims 3, 13, 16, 20, 29, 32, 35, and 37 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 3, 13, 16, 20, 29, 32, 35, and 37 be allowed.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-3, 9, 10, 13-16, 19, 20, and 27-37 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Response should be directed to either Steven R. Ormiston at Telephone No. (208) 634-8591, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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